

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/534,538

Applicant(s)

XI ET AL.

Examiner

SCOTT LONG

Art Unit

1633

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 05 January 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 13 and 15-17

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

/SCOTT LONG/
Primary Examiner, Art Unit 1633

Continuation of 11, does NOT place the application in condition for allowance because:

The applicant has cancelled claim 12. Therefore, the examiner withdraws the rejection of claims 12 and 15-17 under 35 USC 101 and 112, 1st paragraph.

Claim 13 remains rejected under 35 U.S.C. 103(a) as unpatentable over Vuorio et al. (Nucleic Acids Research, 1982; 10:1175-1192) in view of Young et al. (Nucleic Acids Res. 1984; 12 (10), 4207-4228) in view of Nah et al. (Journal of Biological Chemistry, 1991; 266(34): 23446-23452) and further in view of Sandell et al. (Journal of Biological Chemistry, 1984; 259(12): 7826-7834) [known hereinafter as Sandell1] and further in view of Sandell et al. (Journal of Biological Chemistry, 1983; 258(19): 11617-11621) [known hereinafter as Sandell2] and further in view of Upholt et al. (PNAS, April 1986; Vol.83: 2325-2329) for the reasons of record the the comments below.

The examiner has previously put forth his analysis of the differences between the cited art and the claimed invention (see Action, filed 8/27/2010, pages 4-5), namely the nucleic acid point mutation which results in a T24A mutation within the collagen peptide. Because of the record (particularly the 1.132 affidavits that suggesting a typographical error may exist in some chicken collagen II polynucleotide sequences presented by the instant inventors), the examiner suggests that this minor difference, being a typographical error, in view of the cited art makes the entire SEQ ID NO:2 obvious. The examiner requested that the applicant explain this "typographical error" and specifically point out which portion of SEQ ID NO:2 (chicken collagen IIa cDNA) is not taught or suggested by the cited art.

The applicant has not provided an explanation for the "typographical error" and has not specifically indicated which portion of instant SEQ ID NO:2 is not taught by the cited art. Rather, the applicant has made various general assertions that specific references of the cited art do not teach specific portions of the entire chicken collagen IIa cDNA. The examiner has attached a GenBank citation for Chicken Collagen, type II, alpha1 mRNA, which demonstrates that sequences were presented by the cited art and the entirety of SEQ ID NO:2 is covered by the cited art.

The applicant argues that "before the present invention, there was no report about the successful cloning of the full-length cDNA sequence encoding chicken type II collagen and its detailed base sequence or corresponding peptide sequence and as such this is not a case where one simply can piece together various portions of the clones, without sequence information, from the results reported in Vuorio, Young, Nah, Sandell1, Sandell2 and Upholt" (Remarks, filed 1/5/2011, page 4). The examiner disagrees with the applicant's assertion. Skilled artisans daily piece together various portions of clones to compile a detailed base sequence of full length cDNAs for newly discovered genes. This has been made easier since the advent of computer technology for sequence comparison and alignment. Additionally, the knowledge of the protein sequence of chicken collagen, IIa, facilitates some of these alignments. Accordingly, the examiner finds the applicant's arguments unpersuasive.

Likewise, as no distinct argument was made to traverse the rejection of dependent claims 15-17, the examiner maintains the rejection of claims 15-17 under 35 USC 103 as unpatentable Vuorio et al. (Nucleic Acids Research, 1982; 10:1175-1192) in view of Young et al. (Nucleic Acids Res. 1984; 12 (10), 4207-4228) in view of Nah et al. (Journal of Biological Chemistry, 1991; 266(34): 23446-23452) and further in view of Sandell et al. (Journal of Biological Chemistry, 1984; 259(12): 7826-7834) [known hereinafter as Sandell1] and further in view of Sandell et al. (Journal of Biological Chemistry, 1983; 258(19): 11617-11621) [known hereinafter as Sandell2] and further in view of Upholt et al. (PNAS, April 1986; Vol.83: 2325-2329) as applied to claim 13 above, and further in view of Matsumoto et al (US-6,010,722, issued 4 January 2000) for the reasons of record and the comments made in this Advisory Action.

Therefore, the examiner maintains the rejection of claims 13 and 15-17 under 35 USC 103 as being obvious.